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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,229	05/25/2001	Donald R. Youell JR.	ACP 2-021	2603

7590 03/04/2005

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EXAMINER

DURAND, PAUL R

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 03/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No. 09/865,229	Applicant(s) YOUELL ET AL.	
	Examiner Paul Durand	Art Unit 3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2004.  
 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.  
     4a) Of the above claim(s) 6-23 is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1-5 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☒ The drawing(s) filed on 29 January 2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Meyer (US 3,784,004).

Meyer discloses the invention as claimed including a paperboard 12, having a front and back, placing an automobile part 14, that is comprised of a structural part such as a bearing, on the front of the paperboard, leaving front areas exposed and shrink wrapping the part onto the paperboard with film 16 (see Figs. 1-3, C1,L12-20, C3,L49-61 and C5,30-52).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer in view of Gillio-tos et al (US 4,611,456).

Meyer discloses the invention substantially as claimed including a paperboard back. What Meyer does not disclose is the backing being comprised of a laminate. However, Gillio-tos discloses that it is old and well known in the art to use a backing 1, that can be comprised of a laminate as a means of increasing product durability (see Figs. 8,9 and C3,L20-23). Therefore it would have been obvious to one having ordinary skill in the art to have provided the invention of Meyer with a laminate backing as taught by Gillio-tos for the purpose of increasing product durability.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer in view of Engles Jr. (US 3,154,898).

Meyer discloses the invention substantially as claimed except for specific mention of an automobile part being comprised of metal composite or glass. However, Engles teaches that it is old and well known in the art of skin packaging to provide a structural automobile part (i.e. a part having structure) 10, that is comprised of composite metal and porcelain, which is shrink wrapped to a backing 14, by film 16 for the purpose of protecting the product from damage during transport (see Figs. 1-3, C1, L15-18 and C2, L59-69). Therefore, it would have been obvious to one having ordinary skill in the art to have provided the invention of Meyer with the specific skin packaged structural part as taught by Engles for the purpose of protecting the product from damage during transport.

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer and Engles Jr. as applied to claims 1 and 3 and in further view of Kean (US 3,618,755)

In regard to claim 4, the modified invention of Meyer discloses the invention substantially as claimed as applied to claims 1 and 3 above including a packaged article can be comprised of bearings, clutches or various automobile or mechanical parts, which in the broadest reasonable interpretation could include a so called "structural" part (see C5, L30-52). What the modified invention of Meyer does not explicitly disclose is an automobile part that is comprised of window glass, door panel, hood, fender or combinations thereof. However, Kean teaches that it is old and well known in the art of shrink packaging to package glass sheets 21, such as the type found in a window, which are packaged on a corrugated paperboard panel 22 and then shrink wrapped with envelope 35 for the purpose of protecting a product during shipping. Therefore, it would have been obvious to one having ordinary skill in the art to have provided the modified invention of Meyer with a packaged part comprised of window glass for the purpose of protecting a product during shipping.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer in view of Wilkinson (US 6,010,003).

Meyer discloses the invention substantially as claimed except for the method of placing the shrink-wrapped packages in a box or container. However, Wilkinson teaches that it is old and well known in the art to place an object "O" that has been shrink wrapped to a backing with wrap 172, in a container "C" for the purposes of protecting the item during shipping (See Figs. 16 and 17). Therefore, it would have been obvious to one having ordinary skill in the art to have provided the invention of

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Meyer with a shipping container as taught by Wilkinson for the purpose of protecting the items during shipping.

***Response to Amendment***

8. The affidavit under 37 CFR 1.132 filed 7/13/2004 is insufficient to overcome the rejection of claims 2-4 based upon Gillio-tos as applied to claim 2 and Engles as applied to claim 3 as set forth in the last Office action because:

- a. In paragraph 10, the letter from Richard Tracy is unsigned.
- b. In paragraph 11, no factual evidence has been provided of the breakage rate for single pack applications prior to the use of applicant's invention.
- c. In paragraph 12, no factual evidence has been provided to show a considerable decrease in the breakage rate after the use of applicant's invention.
- d. In paragraph 17, no factual evidence has been provided to show a reduced breakage rate of 90%.
- e. In paragraph 18, no factual evidence has been provided to show that Mac-Pack sales have increased 300% due to applicant's invention.

In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

***Response to Arguments***

9. Applicant's arguments filed 7/13/2004 have been fully considered but they are not persuasive.

Applicant first argues that the cited reference of Meyer does not teach the applicant's invention since Meyer does not disclose the use of a structural automobile part. Further applicant relies on the specification to describe structural automobile parts *such as* hoods fenders and doors. This is not persuasive. On Meyer Column 5, Lines 39-42, it is clearly stated that an embodiment of his package can be used for "bearing, clutches or various automobile or mechanical parts." The examiner asserts that the use of *such as* ... in the applicant's disclosure does not limit the type of parts that may be defined as structural on an automobile, and that the examiner certainly considers a bearing a structural part since it must maintain a load or force. Furthermore, while Meyer does not specifically disclose the use of a fender or hood or windshield, the examiner further asserts that it is implicit that "various automobile parts" would fall into that category.

Applicant further argues that the invention of Meyer is not ideal for shipping but rather for corrosion resistance. The examiner disagrees with this argument and asserts that while one benefit from the Meyer invention may be corrosion protection, the purpose of the package in Meyer is to protect the contents as it is being shipped somewhere whether to a storeroom or across the country.

Applicant further argues that the affidavit submitted 7/13/2004 further supports applicant's novelty. The examiner does not agree. As discussed above no factual evidence has been provided to support the claims of either Mr. Tracy or Mr. McLaughlin.

Applicant further argues that Gillio-tos does not teach nor suggest a structural automobile part. The examiner asserts that the teaching of Gillio-tos was chosen for the

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purpose of showing applicant that the use of a laminate backing in skin packaging is well known in the art.

Applicant further traverses the examiner's position of Official Notice for claim 4, and as such the examiner has provided the reference of Kean (see MPEP § 2144.03).

Therefore for the reasons indicated above, the rejection is deemed proper.

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Durand whose telephone number is 571-272-4459. The examiner can normally be reached on 0730-1800, Monday - Thursday.

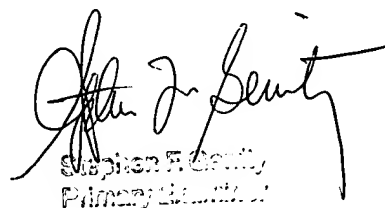


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paul Durand  
February 28, 2005



Stephen F. Durand  
Primary Examiner